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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)
26530.94 / IDR685

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Application Number	Filed
10/776,150	February 11, 2004

First Named Inventor
Ashutosh Vyas, et al.

Art Unit	Examiner
2164	Sathyanarayan R. Pannala

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☐ attorney or agent of record.
Registration number _____.

☑ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 30,222

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Telephone number

February 18, 2008
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

☑ *Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

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REASONS

In the final rejection mailed on October 16, 2007, independent Claims 1, 12, and 20 each stand rejected under 35 U.S.C. §103 as obvious in view of a proposed combination of teachings from Harsham U.S. Pat. No. 6,041,347 and Nguyen, U.S. Patent Application Publication No. 2003/0172145. It is respectfully submitted that these §103 rejections are clearly not proper and are without basis. More specifically, as discussed below, these §103 rejections have clear legal deficiencies, because they lack essential elements needed to establish a prima facie rejection.

I) The Office Action Has Clear Legal Deficiencies Because It Does Establish That The Prior Art Teaches Or Suggests All The Claim Limitations.

In particular, MPEP §2142 specifies that "[t]he examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness." In regard to what an Examiner must show in order to establish a prima facie case of obviousness, MPEP §2143 provides: "To establish a *prima facie* case of obviousness . . . the prior art reference (or references when combined) must teach or suggest all the claim limitations." Some specific examples are discussed below relative to particular claims.

1) Relative to claim 1: The wrong legal standard was applied; the Examiner did not address the process limitations in the method claims. The final Office Action asserts that Harsham and Nguyen together teach the structural elements recited in claim 1 and states in the "Response to Arguments" section that the "use of the claimed invention must result in a *structural difference* between the claimed invention from the prior art" (emphasis added).

This assertion is invalid on its face. Claim 1 is a method claim; rejections based upon a supposed lack of structural difference ***are not applicable*** to method claims. Therefore, the rejection due to a supposed lack of a "structural difference" is a clear legal deficiency. The Examiner has not shown how Harsham and Nguyen either individually or collectively teach the process limitations recited in claim 1. Because the Examiner did not address each process limitation of the method claims (independent claim 1 and its dependents), the Examiner has not shown how the references teach or suggest all the claim limitations as required by MPEP §2143.

Therefore, the Examiner has not established a prima facie case of obviousness relative to claim 1.

2) Relative to claim 1: The Examiner has no discussion of "removing from the set those blocks for which a position cannot be determined." Claim 1 recites the process limitation "removing from the set those blocks for which a position cannot be determined." Discussion of this claim language does not appear ***anywhere*** in the text of the Office Action. This is a clear legal deficiency because it is impossible for the Office Action to claim equivalence between claim 1 and any combination of Harsham and Nguyen if the Office Action does not discuss every element of claim 1 as required by MPEP §2143. Therefore, the Examiner has not established a prima facie case of obviousness relative to claim 1.

3) Relative to claim 12: The Examiner has no discussion of "merging the blocks in a subset of the set" as recited by claim 12. Claim 12 is an apparatus claim that recites "merging the blocks in a subset of the set comprising those blocks for which a position for the new access rule can be determined." Discussion of this claim language in any form does not appear ***anywhere*** in the text of the Office Action. This is a clear legal deficiency because it is impossible for the Office Action to claim equivalence between claim 12 and any combination of Harsham and Nguyen if the Office Action does not discuss every element of claim 12 as required by MPEP §2143. Therefore, the Examiner has not established a prima facie case of obviousness relative to claim 12.

4) Relative to claim 12: The Examiner has disregarded clear structural differences between the claims and the proposed combination of Harsham and Nguyen. Independent claim 12 recites "if the access control list is not empty, creating from the access control list a set of mapped independent rule blocks." The claim further recites "if the set is empty, creating a new independent rule block and inserting the new access rule therein" and "merging the blocks in a subset of the set comprising those blocks for which a position for the new access rule can be determined."

Paragraphs 4 and 11 of the Final Office Action assert that this limitation is taught by Harsham, at col. 4, lines 25-28. The cited text in Harsham, states "[a]ccordingly, in the present

invention, various logical groups of individual machines and groups of machines in the computer network may be defined."

Later, in the text accompanying the Advisory Action, the Examiner asserts that "Harsham do [*sic*] teach this limitation as 'The rules defined for an object 130 are specified at 132. The order of the rules in the list 132 can be changed by selecting a rule and moving the rule up and down using inputs 131 and 133. A selected rule may be edited or removed, as indicated at 134 and 135. A new rule may be added as indicated at 136. Rules inherited from other objects are illustrated at 137.'" (Fig. 71, Col 7, ll. 53-60). (The Examiner does not apply any portion of Nguyen to this portion of the claim.)

As a computer system programmed to perform a function is structure for performing that function, the Examiner's suggested interpretation of Harsham is inconsistent with the language of claim 12. For example:

a) Claim 12 recites "a set of mapped independent rule blocks." The Examiner has not shown how the cited sections of Harsham teach rule blocks that are "independent" or in a "set." This is a clear structural difference between the Examiner's description of Harsham and the language recited by claim 12.

b) Claim 12 recites "a rule insertion engine configured to execute instructions for inserting a new access rule into the access control list." This is significant for two reasons. First, discussion of the "rule insertion engine" does not appear ***anywhere*** in the text of the Office Action. Second, the Advisory Action discusses Fig. 7A, which lays out a graphical user interface for manipulating rules – but the graphical user interface is made specifically for a user to manipulate the rules, and is not a "rule insertion engine configured to execute instructions." If the user is manipulating the rules as described in Harsham, there is no equivalent structure to the "rule insertion engine" recited in claim 12.

For both of the reasons ***a)*** and ***b)***, individually and collectively, the Examiner has not shown that the prior art discloses *every* element of claim 12 as required by MPEP §2143. Therefore, the Examiner has not established a prima facie case of obviousness relative to claim 12.

5) Relative to claim 20: The Examiner has no discussion of "removing from the set those blocks for which a position cannot be determined." Claim 20 is an apparatus claim that recites "computer instructions" including instructions for "removing from the set those blocks for which a position cannot be determined." Discussion of this claim language does not appear ***anywhere*** in the text of the Office Action. This is a clear legal deficiency because it is impossible for the Office Action to claim equivalence between claim 20 and any combination of Harsham and Nguyen if the Office Action does not discuss every element of claim 20 as required by MPEP §2143. Therefore, the Examiner has not established a *prima facie* case of obviousness relative to claim 20.

6) Relative to claims 1, 12, and 20: The Examiner has not shown "merging the blocks" as recited in each independent claim. Claims 1, 12, and 20 of the present application all recite "merging" the independent rule blocks. This claim language is not discussed ***anywhere*** in in any form in the text of the Office Action. This is a clear legal deficiency because it is impossible for the Office Action to claim equivalence between claims 1, 12, or 20 and any combination of Harsham and Nguyen if the Office Action does not discuss every element of the claims as required by MPEP §2143. Therefore, the Examiner has not established a *prima facie* case of obviousness relative to claim 1, 12, or 20.

II) The Office Action Has Clear Legal Deficiencies Because The Proposed References Cannot Properly Be Combined.

When considering the combination of two references, MPEP §2143.01 specifies that "[t]he proposed modification cannot change the principle of operation of a reference. If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious." (Capitalization normalized).

Specifically, the final Office Action asserts that a person of ordinary skill in the art would be motivated to combine Harsham and Nguyen because "all types of providers must position themselves for growth and agility to handle increasing numbers of subscribers, additional services, and workloads that are more challenging" (Nguyen at [0030]). However, Nguyen and Harsham give opposite prescriptions as to how to solve problems of growth and scalability.

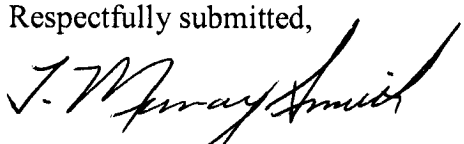
Specifically, Nguyen teaches that "*multi-site distributed systems architectures* may preferably provide . . . improved scaling for mission critical applications." (Nguyen at [0831] emphasis added). In contrast, Harsham states that "management of very large computer networks that are geographically dispersed is a difficult task" and prescribes a "*centralized* computer network management system" (Harsham, col. 1, ll. 39-41, 48-50 emphasis added).

Thus, adopting Nguyen would change the centralized principle of operation specified by Harsham. Since modifying Harsham in view of Nguyen would change a principle of operation of Harsham, the teachings of the Harsham and Nguyen cannot properly be combined. Therefore, the references together are not sufficient to render the claims *prima facie* obvious. Therefore, it is respectfully submitted that the §103 rejections of independent Claims 1, 12, and 20 each lack an essential element needed to establish a prima facie rejection, and each have a clear legal deficiency.

Conclusion

Therefore, as described above relative to MPEP §2143, the §103 rejections are improper because I) they do not teach or suggest all the claim limitations, even when combined in the fashion described by the Examiner, and II) the proposed combination of references would change the principle of operation of a reference. Consequently, the rejections are clearly not proper and are without basis, and it is therefore respectfully requested that they be withdrawn.

Respectfully submitted,



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